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I. Status of Claims

Claims 1-12 are rejected. The appealed claims are 1-12.

II. Grounds of Rejection to be Reviewed on Appeal

Claims 5-12 stand rejected under 35 U.S.C. § 112, ¶ 1 for failing to comply with enablement; claims 1-12 stand rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite; claims 1-12 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; and claims 1-12 stand rejected under 35 U.S.C. § 102 as being anticipated by Newell, U.S. Patent Appn. 2003/0112270. The rejections of claims 1-4 under 35 U.S.C. § 112, ¶ 1 for failing to comply with enablement and claims 5-12 under 35 U.S.C. § 112, ¶ 1 for lack of specific asserted utility or well established utility have been withdrawn in the Examiner's Answer.

III. Argument

Applicants begin by referencing the attached Exhibit A. Exhibit A is a redacted version of the Response to Argument section of the Examiner's Answer. When reviewing the Examiner's Answer, it quickly becomes extremely difficult to follow and understand as the Response to Arguments is replete with duplication of the rejections, quotations from the instant specification, quotations from the Appeal Brief and quotations of statutes, rules and the like. Applicants redacted essentially all of the duplicated rejection language and quotations from the specification to aid in finding any arguments presented by the Examiner. What remained is Exhibit A. Applicants provide a copy of the redacted document to aid the Board in its review process. The document is also encoded to aid in determining the source of the remaining materials. The majority of the document is in the Arial typeface used in the Examiner's Answer. Quotations from the Appeal Brief or Applicants' response of June 21, 2006 are in Times Roman, while quotations from prior Office Actions are in Courier. Applicants have also provided a cite to the starting page in the Examiner's Answer for each portion following a redacted portion to provide easy cross-reference to the full Answer.

A. Section 112, ¶ 1 Enablement

1. Terms in Claims

Throughout the Answer it is noted that various terms such as analyzer and assessor have not been defined. Applicants have responded to prior requests by citing relevant portions of the specification that teach the functions defined in the relevant claims. As the various combinations and functions being performed by claims are submitted as being novel, there are not necessarily defined terms which can be used. As a result Applicants have used terms such as analyzer and assessor to best describe an element that performs the claimed functions. Coupled with the clear teachings of the various functions, it is submitted that the terms are sufficiently defined and any further definitions apparently being required by the Answer are not required.

2. Claim 5

The Examiner's Answer goes on for approximately 14 pages, the majority of it exact duplications of the rejection and quotations from the specification, and most of the remainder being simple paraphrasing of the rejections with little response to Applicants' arguments presented in the Appeal Brief. Indeed, the Answer includes additional errors. For example, the paragraph bridging pages 24 and 25 states that the tool "provides a framework that captures the judgment of seasoned practitioners." This is a misstatement. The tool as defined in claim 5 does not "capture the judgment of seasoned practitioners." That judgment is already incorporated into the weighting values and into the recommendation element. This is similar to any expert system. The expert's knowledge is captured and stored in some manner in the expert system. A non-expert user provides input to the expert system. The expert system then applies the knowledge supplied by the various experts and maintained in some format inside the expert system to provide an answer.

In the next paragraph the Answer states "the invention aggregates a user's judgment and condenses the judgment into a recommendation." This statement is submitted as being a misleading summary. Several different parties are involved in the complete operation of tools according to the present invention. Experienced lawyers provide input to allow selection of weighting values and the operation of the

recommendation element to particular resultant values and decision options. This knowledge is captured in the form of the weighting values and the recommendation element operation. The tool uses this captured knowledge to process the inputs provided by the users of the tool to produce the recommended decision or assessment. This process is clearly not “aggregating a user’s judgment and condensing the judgment into a recommendation.” Indeed, the purpose of the tool is to be used by individuals who are not sufficiently skilled to make a recommendation on their own to get a recommendation based on the knowledge of those skilled and experienced in the area.

The Answer then repeats the phrase that because the values are subjective, there would be different results for different users. As Applicants have stated, with established weighting values and operation of the recommendation element, providing the same input values will provide identical recommended decisions. If the Answer is arguing that providing different input values from different users, given established weighting values and recommendation element, results in different recommendations is the problem, then arguably no system that has some variable output based on variable input values could pass § 112, ¶ 1, even if the entire algorithm, *i.e.* the actual source code and every value, were provided. Applicants note that claim 5 only has selected information gathered. The weighting values are not an input to the claim to be provided by a user. The operation of the recommendation element is not an input to the claim. Both are defined elements which operate on, respectively, the gathered selected information and the resultant values. Only the gathered selected information is an input value, not the others. Thus if the Answer is basing the rejection on all of the gathered selected information, the weighting values and the recommendation element being inputs by the individual user, the Answer is clearly misinterpreting the claim to produce the rejection.

At page 28, after quoting ¶ 29 of the specification that specifically states that “in the preferred embodiment the actual tool runs as a series of Java applications loaded from the server 200 by certain runtime pieces that are installed locally on the workstation 206,” the Answer states that it is not clear that the analyzer is software. Applicants consider this statement to be disingenuous at best. “The tool runs as a series of Java applications.” To anyone skilled in the art this is an express statement that the

preferred embodiment of the tool is software, everyone skilled in the art knowing that a Java application is software. As claimed, the analyzer is part of tool. The tool is software, so the analyzer is software in the preferred embodiment.

The Answer eventually addresses the arguments made in the Appeal Brief by stating on page 31 that the “Examiner asserts that it is unclear what appellant means by ‘[a]ny numerical values utilized in the analysis process are internal to the tool itself and are used in the internal calculations and analysis’ and ‘[a]s such, these numerical values need not necessarily have a specific meaning to a person in the industry.’” No discussion is provided addressing the remainder of Applicants’ remarks on pp. 12 – 13 where Applicants go into further explanation and provide a set of analogies. Providing another example, the logic of the Answer would reject any expert system where every internal value is not a unit or value well known to those skilled in the art. Applicants submit that is effectively every known expert system. Neural networks receive inputs and provide outputs. The internal operations of the neural network are usually governed by weighting values applied to the various inputs. Do all of the internal values of a neural network need to be known to one skilled in the art to pass § 112, ¶ 1? Clearly not. As previously argued, the weighting values, the resultant values and the like are defined for a particular implementation. They are not absolutes and any particular value need not have meaning a priori to one skilled on the art. The importance is the relationships defined in the claims and described quite adequately in the specification and reiterated in the Appeal Brief.

3. Claim 6

The Answer continues the rejection of claim 6, again simply stating that the elements are not enabled. Applicants quote portions of ¶ 36 of the specification which provides examples of machine learning techniques which can use prior case results to develop recommendations.

In more complicated situations, such as the full case recommendation shown in Figure 4, the individual recommendations and other data points are matched against a statistical decision tree, providing a recommendation for those cases. The statistical decision tree is developed with prior case results and/or input from experienced lawyers. In other alternatives for both the simpler and more complex situations, various machine learning techniques can be used, with complementary techniques

used to provide the recommendations. Examples include supervised feedback learning via an N-dimensional hyperplane classifier, a variation on the ID3 algorithm of Quinlan, self organizing mapping techniques according to Teuvo Kohonen and other neural network techniques. The particular data collected from the user may vary by the particular techniques used to ensure convergence, but all data would be similar to that illustrated herein.

Applicants submit that claim 6 is clearly enabled when this language is considered.

4. Claim 8

The Answer also continues with the assertions that the assessment functions of claim 8 are not capable for providing a predictable and repeatable assessment, based largely on the rejections and remarks relating to claim 5. Applicants note that this statement is made immediately following a quotation where Applicants set out the relevant portions of the specification. The claim language is clear. The teachings of the specification are clear to one skilled in the art. As with claim 5, the operation is predictable and repeatable.

5. Claims 9 – 12

The Answer continues the rejection of claims 9 – 12 based on an alleged failure to describe the decision tree. After quoting ¶ 36 of the specification and portions of Applicants' remarks regarding the statistical decision tree, the Answer simply makes the conclusory statement without addressing ¶ 36 or Applicants' remarks. Applicants submit that this non-response, as with the effective non-responses relating to claims 5, 6 and 8, is an admission of the improper nature of the rejection. If there was any support for the conclusion, it should have been provided. Instead, as previously, just the conclusion is repeated. The rejection is clearly improper and should be reversed.

B. Section 112, ¶ 2 Indefinite

1. Claim 1

The Answer makes passing mention of MPEP 2111 and the need to give claim limitations the broadest reasonable interpretation in light of the specification but then goes on to completely ignore both the specification and the remaining claim

elements in making extreme interpretations of the claim elements. The drawings include 97 pages of screenshots, clearly a graphical user interface, and one page illustrating the exemplary computer system of the preferred embodiment. Of particular note to claim 1 are Fig. 100 and any of Figs. 4-99. Claim 1 requires both an entry field to request collection of discovery requests and a menu for gathering discovery related information. The Answer simply ignores the context of the menu, namely that it is in response to a request using the entry field, and the specification entirely, such as Fig. 100 and ¶ 53 which describes Fig. 100. When considered in context of the claim and in light of the specification, it is clear that the menu is a structural element of an apparatus.

The Answer then again states that “form materials” are not the structure of an apparatus. Again this is only done by basically totally ignoring the claim and the specification. Paragraph 54 states that the tool selects the particular discovery questions and merges them with other form discovery materials. When the merger is done the related output is developed, generally with suitable word processing tools. To perform the merger to develop the related output with word processing tools, both the particular discovery questions and form discovery materials must be data that is stored to allow the operation. This is clear from the claim element, from ¶ 54 and from the specification as a whole which clearly is describing a computer-based tool. Thus the form discovery materials are properly structure of an apparatus.

The Answer then provides the most egregious example of ignoring the specification completely by interpreting the discovery production mechanism to be a stapler. MPEP 2111 says “reasonable” “in light of the specification.” Applicants submit that this interpretation of the element as a stapler simply is not reasonable in light of the specification or the claim.

Skipping forward a few pages in the Answer to p. 40 in relation to “entry field”, the Answer quotes Applicants’ response (which notes that the Office Action did not respond to Applicants’ prior response) and then proceeds to fail to address even the arguments quoted, merely stating it still does not clarify. Applicants therefore will reinforce the arguments of the Appeal Brief. As a specific embodiment Applicants refer to each of Figs. 4-98 and note the button labeled “Discovery Generator” in the upper right corner of the screen shot. Applicants then note that none of Figs. 4-98 are directly related

to discovery. As stated in ¶ 53, clicking “Discovery Generator” brings up the drop down box of Fig. 100, which is for entering specific discovery questions, which is an example of the menu element of claim 1. Clearly the “Discovery Generator” button is an entry field on a plurality of views (Figs. 4-98) not directly related to discovery and is to request collection of discovery requests (drop down box of Fig. 100 and ¶¶ 53-54).

2. Claim 5

The Answer at p. 39 quotes Applicants’ remarks regarding a definition for “analyzer,” which reference prior examples and ¶ 36 of the specification. Despite quoting these responses the Answer alleges that Applicants have never responded or defined the term analyzer. The Answer then ignores MPEP 2111 and states an “analyzer” can encompass a human being.

As to “analyzer,” Applicants note that the claim language is “an analyzer for using the stored selected information and the associated weighting values to determine a resultant value.” Paragraph 29 states that the preferred embodiment of the tool runs as a series of Java applications. The first element “interfaces” are shown in Figs. 4-98, which clearly are screenshots of user interfaces of computer software. The next element is storage. Paragraph 29 specifically states that the server 200 provides storage space for the programs and data. Paragraph 36 describes the operations in detail, with the stored data values combined with weighting values to form a score which is translated into a recommendation. The score to recommendation translation can be based on the input of experienced lawyers and/or on prior case analysis, which is further explained in ¶ 36. Applicants submit that these and prior remarks have clearly identified portions of the specification and claims which identify the term analyzer. To argue that the term encompasses a human being entirely ignores MPEP 2111 and is an unreasonable interpretation, similar to the unreasonable interpretations being done with regard to claim 1.

3. Claim 8

The Answer states that Applicant has yet to identify or define the term “assessor.” In responding to the now withdrawn § 112, ¶ 1 utility rejections, Applicants described at length, in response to a rejection that the assessment of claim 8 was not

described, how the assessment was made. Clearly this description was sufficient to explain how an assessment is made as the rejection has been withdrawn. Noting, as mentioned previously, that ¶ 29 indicates the preferred embodiment tool runs as a series of Java applications, Applicants then quote from p. 16 of the Appeal Brief where the assessment response was made:

Applicants first refer to ¶ 30 and Fig. 4. Recommendation 310 is the assessment for the illustrated case. Quoting from ¶ 30: “This is based on the analysis of the collected data and case history review of similar cases and provides a recommendation as to the assessment and procedure for the particular case.” Thus the assessment is the recommendation for the overall litigation, not just a recommendation on one decision or element of the litigation. Paragraph 31 describes an overview of the various steps and states: “Each of these are task and data gathering steps to help develop recommendations. The actual data gathered is used in a weighted manner to help determine the recommendation.” Proceeding then to ¶ 33, which relates to business/venue analysis, it states: “The result of the assessment and weight value factoring is used to help calculate recommendations provided by the tool.” Next proceed to ¶¶ 35 and 36, discussed above in more detail, which provide details on removal analysis and also the general analysis techniques and methods used in the illustrated embodiments of the invention. Paragraphs 38 (responsive pleading task), 41 (claim and evidence), 42 (particular termination), 43 (prior charges), 44 (comparator), 45 (decision to terminate) and 50 (damages) discuss further data used in the weighting analysis. See ¶ 49 which states: “Thus, this is a systematic way to gather all of the proof points necessary for the case, with the proof point data being used in the weighting analysis to help determine overall recommendation for the particular case.”

With that, it is very clear that Applicants have identified teachings in the specification relating to the “assessor” element of claim 8.

4. Tool Rejections

The Answer apparently continues the rejection regarding inability to determine the statutory class of the claims. All three claims recite a “tool.” There has been significant discussion about the definition of “tool” and how the various elements of each meet the requirements. On page 40 the Answer simply concludes that it is unclear how a menu, form discovery materials, weighting values, resultant values, etc., provide structure. Applicants have discussed menu and form discovery material at length above so it is clear that they are proper apparatus elements. Weighting values and resultant

values in claim 5 are clearly stored data values used, respectively, by the analyzer and recommendation elements in their operation. The weighting values are input constants used by the analyzer. The resultant values are the output of the analyzer and the input to the recommendation element. Thus they are elements integrally tied to the operation of undisputed apparatus elements. As such, they are also clearly proper apparatus elements.

The Answer also continues the rejection of claim 8. After quoting Applicants' remarks but failing to address them, the Answer provides an additional series of questions. As a first point, Applicants note that claim 8 requires "a plurality of tools according to claim 5." The Answer somehow appears to interpret this as using the same tool a plurality of times. Claim 5 defines a tool, say a wrench to continue the analogy. Of course we all know that wrenches come in various types, open end, box, combination; and sizes, 5/8, 9/16, 10 mm, 12 mm. So would tools according to claim 5. Indeed, the specification describes several. Fig. 19-22 and ¶ 35 are for removal analysis. Fig. 21 specifically shows a recommendation. Figs. 23-28 and ¶ 38 are for the responsive pleading. Figures 23-28 show a recommendation. Thus the specification clearly shows two different tools that can be used in the same litigation, at least partially answering the newly provided question of why you would use a plurality of tools, basically because each tool covers a different aspect of the litigation. As to where the decisions come from in claim 5, Applicants refer to the last element of claim 5, the recommendation element, which provides a recommended decision. Thus the final output of a tool according to claim 5 is a decision. Paragraph 36 then specifically states that the individual recommendations, the decisions in the language of claim 8, and other data points gathered from the interfaces of claim 8, are matched against a statistical decision tree to provide a full case recommendation as shown in Fig. 4. One would use several different wrenches (plurality of tools) according to Fig. 5, and a screwdriver (analogous to the further selected information) to assemble a bicycle. Applicants submit that claim 8 is clear and distinct when read in light of the specification.

C. Section 101

1. Statutory Class

The Answer continues the rejection related to not understanding which statutory class the invention falls into. To a great extent the remarks are the same as those made with regard to the § 112, ¶ 2 rejections of the same basis. As Applicants have previously addressed the arguments under the § 112, ¶ 2 rejection, Applicants simply note that they apply and do not repeat them here.

The Answer does raise a new line when it states that it is not clear whether the tool is software or a web site or web pages. The Answer states that web sites or web pages require careful analysis because they could simply be a collection of files. Applicants note that such remarks are made and then only selected portions of each of the independent claims are mentioned. The Answer omits elements in each claim which require more than a static file. Claim 1 includes a discovery production mechanism to combine discovery related information and form discovery materials. Claim 5 requires an analyzer to determine a resultant value and a recommendation element to provide a decision. Claim 8 requires a plurality of tools according to claim 5 to provide decisions and an assessor utilizing the decisions to provide an assessment. None of those elements can be mere static files as they all require performing selected actions. As it is the claim as a whole that must be considered for § 101 analysis, not merely just selected elements as done in the Answer, it is clear that the claims are clearly apparatus claims and are statutory.

2. Concrete Results

As best Applicant can determine from the Answer, Claims 5-12 are rejected as not producing a concrete result. After posing the question on p. 50, the Answer then effectively repeats the entire § 112, ¶ 1 rejection and remarks for thirteen pages, arguing as above about the subjective nature, the lack of disclosure on weighting values and resultant values and continuing to confuse the user inputs to the tool and the experienced attorney use to develop the weighting values and analyzer and recommendation element operation. Applicants have, again, fully explained this with regard to the § 112, ¶ 1 rejection and remarks but repeat here briefly that for any given

set of inputs from a user, the tool will produce the same recommendation as the weighting values and analyzer, recommendation element and assessor operation are fixed, not being based on those user inputs. Applicants submit that when the claims are properly construed, the claims already provide the required concrete results.

3. Guidelines Analysis

The Answer at page 47 appears to begin a guidelines analysis (MPEP 2106) but fails to complete the analysis, simply stopping when it is concluded that the claims are not concrete. The Answer fails to complete the analysis, namely the determination of whether the claims preempt the abstract idea, law of nature or natural phenomenon. In this case it is clear that the claims do not cover any use of the ideas but are limited to practical results, namely decisions or assessments in litigation.

D. Section 102

1. Claim 1

The Answer continues to basically ignore major elements of the claim when performing the analysis based on alleged failure of Applicants to clarify the limitations, namely the entry field and the discovery production mechanism. Applicants disagree. Indeed the Answer quoted Applicants' response to the entry field question. Applicants have elaborated on the description above. As to the discovery production mechanism, the Answer does correctly note that the discovery production mechanism was the subject of a § 112, ¶ 1 Enablement rejection which has now been withdrawn. For reference, page 11 of the Appeal Brief addressed that rejection. Therefore, Applicants had clearly clarified the claim limitation. Instead the Answer now falls back on the § 112, ¶ 1 Indefinite rejection to effectively ignore the term.¹ As Applicants have previously argued above about the term and submit that continuing to ignore it is improper.

¹ Applicants note that the Answer appears to equate the mechanism with a stapler, but the § 102 rejection only references ¶ 100 of Newell, which does not teach or suggest a stapler. Nor is there any discussion how a stapler could be combined with the other elements cited in Newell. Thus even under the unreasonable interpretation of the element as being met by a stapler the Answer has not made a proper rejection.

The Answer argues that Applicants do not disclose how the tool selects the particular question or how the data is merged. The Answer makes this argument directly after quoting ¶¶ 53 and 54 of the specification where the operation is described. Paragraph 53 indicates the class or category of discovery, to whom the discovery is directed and the ultimate question is entered into the drop down box developed when the Discovery Generator button is clicked. Paragraph 54 goes on to describe the merger process. A particular category of discovery is selected by using the screen of Fig. 99. In certain cases individual names are selected. The tool then selects the particular discovery questions, *i.e.*, those described in ¶ 53 as having category of description and individual identified which match the category and individual entered into the Fig. 99 screen. This operation is clear to anyone skilled in the art from the specification and the relevant figures. Thus the argument of the Answer is clearly improper.

The Answer then argues it is unclear what gets incorporated into the materials or what the final product is. As to the incorporation point, as described above particular questions are selected based on the category and individual. So clearly the ultimate questions described in ¶ 53 are incorporated. As to the final product, one skilled in the art clearly understands that depends on the category. Fig. 99 lists interrogatories, request for production, request for admission, deposition questions, witness questions and agency requests as examples of categories. Each of these categories has a normal format, which generally varies between the categories. One skilled in the art would be familiar with each category and the output would clearly be in the proper format for the category.

The Answer then proceeds to give little patentable weight to the qualifiers in the entry field and menu elements, dismissing them as being merely for the intended use. Applicants submit this is improper. Developing litigation discovery material is not just the intended use, it is the claimed use. The discovery production mechanism specifically produces discovery items for use in litigation. Therefore the qualifiers are entitled to full weight, not to be ignored as has been done.

Applicants acknowledge that Newell may incorporate discovery materials, as it should given its document management function. However, as it is just effectively a storage center, it clearly does not teach or suggest the required entry field, menu or discovery production mechanism when the claim limitations are fully considered and not improperly ignored.

2. Claim 5

As with claim 1 the major elements of the claim are improperly ignored in making the rejection. Again this is based on Applicants' alleged failure to define an element, this time the recommendation element. Further, several terms are ignored because they are not considered proper structural elements. Finally little weight is given to the element qualifiers based on the intended use declaration.

Applicants have previously referenced ¶ 36 which describes the operation of the recommendation element. The various terms have been argued as being proper statutory items, both previously and above.

In the "little weight" point, the Answer makes the same error as made with respect to claim 1, namely ignoring that a recommended decision in litigation is the claimed output of the recommendation element, not merely an intended use. As to "for gathering information" in the interfaces element, the "for" clause defines the purpose and nature of the interfaces, not just their intended use. The information gathered from the interfaces is then used by the analyzer. The gathered information is specifically operated on by the analyzer. It is not merely the intended use of the interfaces, it is the defined purpose of the interfaces, to gather information used by the analyzer. Ignoring it as has been done is completely improper.

As Applicants have previously stated Newell does not disclose any of the claim elements starting at weighting values.

Ignoring the elements or their limitations is simply improper and the rejection is wholly improper.

3. **Claim 8**

As with claims 1 and 5, the Answer argues that certain clauses are for intended use and that the assessor element has not been defined. The Answer further defines the assessor as the processor 112 of Newell.

“For assessing a litigation” is not just the intended use, it is the claimed use. The output of the assessor is an assessment of the litigation. Thus the clause is entitled to full weight, not being ignored. As to the assessor element, Applicants note that how an assessment is provided was the basis of a § 112, ¶ 2 Utility rejection, which has been withdrawn. The discussion is at pages 16 and 17 of the Appeal Brief. Clearly as claimed the assessor makes the assessment. Given the withdrawal of the utility rejection, Applicants submit that the teachings of the assessor in the specification have clearly been pointed out.

As to the newly made correspondence between the processor 112 and the assessor,² Applicants submit that there has been no showing that the processor 112 provides the claimed output of the assessor, namely an assessment of a litigation. As such even this new rejection basis is improper.

As previously argued, Newell clearly does not disclose a plurality of tools or an assessor when the terms are actually considered properly.

E. Conclusion

Applicants respectfully submit that the rejections of indicated claims are improper and should be reversed.

Respectfully submitted,

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² Applicants note that the assessor element is not even mentioned in the § 102 rejection, so this correspondence, first provided in the Answer, is clearly new. Indeed, Applicants note that none of the individual elements of claim 8 are even listed in the § 102 rejection.

Exhibit A

(10) Response to Argument

A. Section 112, 1st paragraph, Enablement

¹The Examiner rejects claims 5-12 stating that the claims are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement because the claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 5 is directed to:

A tool for recommending a decision in litigation, the tool comprising:
interfaces for gathering selected information relevant to the decision;
storage for the gathered selected information;
weighting values associated with each element of selected information;
an analyzer for using the stored selected information and the associated weighting values to determine a resultant value; resultant values associated with various decision options; and
a recommendation element using the determined resultant value and the associated decision options to provide a recommended decision.

Claim 8 is directed to:

A tool for assessing a litigation, comprising:
a plurality of tools according to claim 5, each tool for a decision in the litigation;
interfaces for gathering further selected information relevant to the litigation;
storage for the further selected information; and
an assessor utilizing the decisions of each of said plurality of tools and the stored further selected information for providing an assessment.

...

¹ Examiner's Answer, p. 17

Claim 8 is directed to a tool comprising a plurality of tools, interfaces, storage and an accessor. Claim 8 discloses an accessor utilizing the decisions of each of the plurality of tools for providing an assessment relating to litigation.

²At the onset, the Examiner notes that neither the term "analyzer" nor the term "accessor" are identified in the body of the specification or any of the drawings. The only place that these terms are found are in the claim limitations.

...

... ³There is no guidance or direction as to how these resultant values are associated with various decision options. ... ⁴which is used to provide a recommended decision.

...

... ⁵As set forth in appellant's specification, the invention is directed to a tool that provides an analytical framework that captures the judgment of seasoned practitioners to provide a comprehensive analysis of the legal, factual, and business aspects of a lawsuit (abstract). The tool directs the attorney to assign values to reflect the importance of various aspects of the litigation. Based on the values that are assigned and the attorney's assessment of particular aspects of the litigation and statistical assessments of likely outcomes based on historical records previously captured and analogous assessments, the tool provides the attorney with suggested paths. Through this process, counsel, in cooperation with the client, analyze the strengths and weaknesses of a case and determine the appropriate path forward [0014-0015]. The actual data gathered is used in a weighted manner to help determine the recommendation. The actual weighting values are based on assessments of criticality for each particular response as determined by skilled and experienced lawyers in the field [0031]. Appellant discloses that each of the data values includes a particular value which is

² Examiner's Answer, p. 19

³ Examiner's Answer, p. 20

⁴ Examiner's Answer, p. 21

⁵ Examiner's Answer, p. 23

used in a weighted analysis as derived by an experienced lawyer. Experienced lawyers provide weighting factors for each particular data value. These weighting values are then combined to form a score which is then translated into a recommendation [0036].

The Examiner notes that appellant's invention takes the subjective input of a user and enters it into the computer to produce a recommendation. ... As set forth above, appellant's invention is a tool that provides a framework that ***captures the judgment of seasoned practitioners***. The actual weighting values are ***based on assessments of criticality for each particular response as determined by skilled and experience lawyers***. This actual data gathered is used in a weighted manner to determine a recommendation.

The Examiner asserts that the appellant does not provide sufficient guidance or direction as to an actual numerical value being used or how the value is assigned or weighted. As set forth above, the invention aggregates a user's judgment and condenses the judgment into a recommendation. It is unclear from the disclosure how a computer would be programmed, without undue experimentation, to provide a value and assign or weight the value in order to take into account all of the subjective answers which the process entails. Although the instant specification is replete with generalizations regarding the values, it is short on any specific direction or guidance as to what the values actually are or how they are assigned or weighted. It is the subjective nature of appellant's input into the computer and the lack of guidance and direction as to the meaning and application of values that raises the question of enablement. The Examiner asserts that it is the subjective analysis and judgments utilized to apply undefined values that prevents the invention from producing a repeatable and predictable result without undue experimentation.

...

⁶The Examiner asserts that while this statement is extremely clear, the claimed invention is not capable of producing a concrete result, i.e., a predictable and reproducible result without undue experimentation due to the lack of guidance and

⁶ Examiner's Answer, p. 27

direction provided by appellant as to what these weighted values are or how they are applied. The fact that the actual ***weighting values are based on assessments of criticality*** for each particular response ***as determined by skilled and experienced lawyers*** in the field is further evidence that the invention is not enabled due to quantity of experimentation needed to make and use the appellant's invention so that it provides a predictable and repeatable result as required by statute. The Examiner asserts that assessments by skilled and experienced lawyers are not repeatable nor predictable.

Appellant states that the Examiner next questions how the analyzer determines a resultant value. In response, appellant states:

Applicants quote from ¶ 36: "the weighting values are then combined to form a score, which is then translated into a recommendation."

In response to the Examiner's question as to how they [the weighted values] are combined, the appellant states:

Again that is relevant only to the internal operation of the tool, as the score is then translated into a recommendation. This is clear in the next sentence in ¶ 36: "Again, *experienced lawyers would select the scores for a particular recommendation.*"

In response to the Examiner's question of what defines an analyzer, is it a person or software, the appellant states that:

As the claimed invention is a tool, it is extremely clear that the analyzer is software. See ¶ 29: "Fig. 2 illustrates an exemplary computer system for operating a tool according to the present invention" and "In the preferred embodiment the actual tool runs as a series of Java applications loaded from the server 200 by certain runtime pieces that are installed locally on the workstation 206."

The Examiner asserts that as set forth in appellant's specification, it is not clear that the analyzer is software. Since it is not identified in the specification or in any drawings as software, a person could easily look at the computer screens displaying the

stored information and the associated weighting values and determine a resultant value, thus becoming an analyzer.

The appellant then states that specification is sufficiently enabling when considered by one skilled in the art. Appellant further states that the rejection as it related to claim 5 and a *purported subjective interpretation* is confusing the inputs to the tool used to perform the analysis with the [actual] analysis.

The appellant states that the analysis operates on these subjective values provided by the users. The appellant further states that, contrary to the rejection, the analysis will always produce the same result when the same values are provided. Appellant further asserts that the analysis might produce different results where different values are provided, but appellant asserts that this is the purpose of the analysis, to operate on the values provided. Appellant then states that most equations will produce different results when different values are provided. Appellant states that, contrary to the statements of the rejection, the users conduct no experimentation, they simply answer the provided questions in the illustrated embodiments and the recommendation element then provides the resulting recommendation. (The Examiner notes that the term "recommendation element" is not identified in the specification or drawings but only used in the claim limitations).

Thus, the Examiner asserts that the claims contain subject matter that was not described in the specification in such a way as to enable one skilled in the art to make or use the invention without undue experimentation since the subjective nature renders the invention incapable of providing a concrete, i.e., predictable and repeatable, result as required by statute. To be statutory, an invention must provide a repeatable and predictable result. The Examiner asserts that because the appellant has failed to provide sufficient guidance and direction to provide the necessary repeatable and predictable results, one skilled in the art would have to perform undue experimentation to make or use the invention. The Examiner asserts that unspecified values assigned in an unspecified way render it virtually impossible for one of ordinary skill in the art to make and use appellant's invention without undue experimentation. As set forth by appellant in the Appeal Brief (page 12), the weighted analysis values are utilized to form a score with the score translated to a recommendation. Appellant states in the Appeal Brief (page 13), that the actual weighting values are based on assessments of criticality

for each particular response as determined by skilled and experience lawyers in the field. These statement, in and of itself, is evidence of the inability to produce a repeatable and predictable result. Because the appellant has not provided sufficient guidance and direction and because the values are subjective, for a single situation, there could be different results based on this subjective analysis and determination of each user. The subjective values would result in different scores, and thus different recommendation, depending on the individual users. Even for the same fact situation, different users could come up with different scores and thus a different recommendation. Thus, for a given situation, for each individual performing the invention, the score derived from the weighted analysis, and thus the recommendation, could be different. Therefore, the Examiner submits that the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to user the invention - to the point that the users become the inventor of their own application of the invention rather than the applicant. As set forth above, appellant has not defined what scale is used, what the weighted analysis values are or how they are applied, or how the resulting score can be translated into a recommendation. As stated by appellant in the Appeal Brief (page 12), the actual numerical values would likely vary based on the specific techniques utilized. Appellant further states that once the particular entry value correlations, weighting analysis techniques and so on are defined for a particular embodiment, then a particular numerical value develops meaning, but not until then. The Examiner asserts that it is unclear what appellant means by "[a]ny numerical values utilized in the analysis process are internal to the tool itself and are used in the internal calculations and analysis" and "[a]s such, these numerical values need not necessarily have a specific meaning to a person in the industry" (page 12 of the Appeal Brief).

Claim 5 claims a recommendation element using the determined resultant value and the associated decision option to provide a recommended decision. The Examiner requested that the appellant identify what defines a "recommendation element" since it is not identified in the specification. Furthermore, the Examiner asserts that there is not sufficient guidance and direction in appellant's specification to enable one skilled in the

art to use the determined resultant value and the associated decision options to provide a recommended decision without undue experimentation.

In the instant Appeal Brief, the appellant states that:

As to the recommendation element, Applicants quote ¶ 36: "The weighting values are then combined to form a score, which is then translated into a recommendation. Again, experienced lawyers would select the scores for each particular recommendation." Thus the recommendation element takes the resultant values, the weighting values in ¶ 36, and combines them to form a score, which is translated to a recommendation, the recommended decision. The particular scores are correlated to a particular recommendation based on input from experienced lawyers. Applicants refer to ¶¶ 35-37 for an example on how a recommended decision is made. As explained for that embodiment, entry or data values are used in a weighted analysis. The weighting values are combined to form a score, which is translated to a recommendation. Other methods are then mentioned, including correlation and statistical decision tree analysis. Applicants thus submit it is very clear what the recommendation element is and how the recommended decision is made.

The Examiner asserts that appellant has provides generalities, i.e. combining undefined weighted values to form an undefined score. Appellant then states that this undefined score is translated into a recommendation. Appellant states that the undefined "recommendation element" takes the undefined resultant values, the undefined weighting values and combine them into a score, wherein the meaning to the score or the relevance of the score is also undefined. Appellant states that the scores are correlated to a particular recommendation based on input from experienced lawyers. It is unclear what qualifies one as an "experienced lawyer".

Claim 6 is directed to the tool of claim 5, further comprising a collection of results of the decision in prior litigation and the selected information for those litigations and wherein one of said analyzer and said recommendation element utilize said collected results to develop a resultant value or recommended decisions. ...

⁷Claim 8 states that and accessor utilizes the decisions of each of the plurality of tools and the stored information to provide an assessment.

⁷ Examiner's Answer, p. 32

As to how the assessment is provided, appellant states that:

Applicants first refer to [paragraph] 30 and Fig. 4. Recommendation 310 is the assessment for the illustrated case. Quoting from [paragraph] 30: "This is based on the analysis of the collected data and case history review of similar cases and provides a recommendation as to the assessment and procedure for the particular case." Thus the assessment is the recommendation for the overall litigation, not just a recommendation on one decision or element of the litigation. Paragraph 31 describes an overview of the various steps and states: "Each of these are task and data gathering steps to help develop recommendations. The actual data gathered is used in a weighted manner to help determine the recommendation." Proceeding then to [paragraph] 33, which relates to business/venue analysis, it states: "The result of the assessment and weight value factoring is used to help calculate recommendations provided by the tool." Next proceed to [paragraphs] 35 and 36, discussed above in more detail, which provide details on removal analysis and also the general analysis techniques and methods used in the illustrated embodiments of the invention. Paragraphs 38 (responsive pleading task), 41 (claim and evidence), 42 (particular termination), 43 (prior charges), 44 (comparator), 45 (decision to terminate) and 50 (damages) discuss further data used in the weighting analysis. *See* ~ 49 which states: "Thus, this is a systematic way to gather all of the proof points necessary for the case, with the proof point data being used in the weighting analysis to help determine overall recommendation for the particular case." Applicants submit that the specification does describe a technique to provide an assessment or overall recommendation of the case and therefore the rejection is improper.

For the reasons set forth as to the discussion as to claim 5, the Examiner asserts that the subjective input utilized in the decisions of the plurality of tools and the selected information renders the invention incapable of providing a predictable and repeatable assessment as required by statute without undue experimentation. The specification does not describe how the assessment is performed or what goes into the assessment in such a way as to enable one skilled in the art to make or use the invention. Furthermore, the term "accessor" has not been defined in the specification or identified in the drawings. Thus, it is unclear whether the term encompasses a human or not.

...

⁸In the arguments submitted with the Appeal Brief (page 17), appellant states:

Applicants traverse the rejection. The use of a statistical decision tree is specifically mentioned in ¶ 36. Applicants quote: "In the more complicated situations, such as the full case recommendation shown in Fig. 4, the individual recommendations and other data points are matched against a statistical decision tree, providing a recommendation for those cases. *The statistical decision tree is developed from prior case results and/or input from experienced lawyers.*" Applicants submit that statistical decision trees and the particulars of their development are well known to those skilled in the art and thus are not required to be explained in detail. A simple search on Google results in thousands of hits, one indicator that the technique is well known. Reversal of the rejection is requested.

... ⁹or how the tree is used to provide a recommendation. ... ¹⁰or how the tree is used to provide a recommendation. Thus, the Examiner asserts that one skilled in the art would not be able to make or use appellant's invention without undue experimentation.

B. Section 112, 1st paragraph Utility

This rejection has been *withdrawn*.

C. Section 112, 2nd paragraph (indefinite)

Note: The Examiner notes that appellant indicates that this is "B".

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

...

⁸ Examiner's Answer, p. 34

⁹ Examiner's Answer, p. 35

¹⁰ Examiner's Answer, p. 35

¹¹In the amendment submitted by the appellant on June 21, 2006, the appellant states in the Remarks/Argument section that:

The Office Action rejects claims 1-12 under § 112, ¶ 2 for several reasons. First, the Office Action states it is unclear which statutory class the invention falls into. *Applicants submit the present claims are properly classified as apparatus or system claims.* The present claims are a combination of graphical user interface elements and related data fields (*See* claim 1, entry field and view), physical storage (*See* claim 1, storage), stored information (form discovery materials), and a generally computer-implemented process (discovery production mechanism). Claims 5 and 8 have similar correlations. Each element clearly falls into the apparatus classification, so the whole invention must then also fall into the apparatus classification.

Second, the Office Action requests a definition for "a tool." Applicants are using normal meaning for the term. For example, *tool* as a noun is defined as "*something (as an instrument or apparatus) used in performing an operation or necessary in the practice of a vocation or profession*" in Webster's Ninth New Collegiate Dictionary. When the specification and claims are reviewed, Applicants submit that their use of the word is consistent with that definition, an ordinary meaning of the word "tool."

Third, the Office Action requests clarification of the phrase "an entry field ..." in claim 1. As a specific embodiment, and not a limitation to the claim language, Applicants refer to ¶¶ 53 and 54 and to Figs. 4, 99 and 100. As seen on Fig. 4, there is a button labeled "Discovery Generator." Clicking this button results in the drop down box shown in Fig. 100 appearing on screen. The drop down box is for entering specific discovery questions. As the "Discovery Generator" button is present on screens not directly related to discovery, as in Fig. 4, this Discovery Questions entry area is available on these other views. Applicants again note that this is a specific explanation of a specific described embodiment and is not to limit the meaning of the claim term to that specific example.

Fourth, the Office Action requested identification of an "analyzer." Applicants respectfully submit that numerous examples have been described above, such as with reference to ¶ 36, and no further explanation is necessary here.

Fifth and finally, the Office Action is confused by the use of "tool" for both claim 5, and claim 8 which incorporates claim 5. Applicants submit that the response related to the claim objections addressed this rejection.

¹¹ Examiner's Answer, p. 36

In the instant appeal brief, appellant states that the present claims are properly classified as apparatus or system claims. Appellant states that the present claims are:

A combination of graphical user interface elements and related data fields (See claim 1, entry field and menu), physical storage (See claim 1, storage), stored information (form discovery materials), and a generally computer-implemented process (discovery production mechanism). Claims 5 and 8 have similar correlations. Each element clearly falls into the apparatus classification, so the whole invention must then also fall into the apparatus classification.

The Examiner notes that claim 1 is directed to a tool, comprising, an entry field available on a plurality of views, a menu for gathering information, storage of information, form materials and a production mechanism for combining information.

The appellant states in the instant Appeal Brief that:

The Office Action baldly states that a menu and form materials are clearly not proper structure for an apparatus but are written data. The Office Action errs in those points. A menu, particularly the claimed menu which is responsive to a request using an entry field, is clearly a user interface element, which is classically an apparatus element. Form materials are also not just written data but would be stored so that they can be combined by the discovery production mechanism, which is not disputed as being an apparatus. Thus those elements are sufficient so that it is clear that the claim is for an apparatus.

First, the Examiner asserts that MPEP 2111 requires the Examiner to give claim limitations the broadest reasonable interpretation in light of the specification without reading limitations from the specification into the claims.

The Examiner asserts that a menu, as claimed, is not clearly a user interface element. Moreover, a user interface element can be software which is not structure. A graphical user interface (GUI) is structure, but appellant has not claimed a GUI. Moreover, the Examiner asserts that a GUI would display a menu but the menu, in and of itself, is not structure.

Furthermore, the Examiner disagrees with the appellant's argument that "form materials are also not just written data but would be stored so that they can be combined by the discovery production mechanism, which is not disputed as being an

apparatus". The Examiner asserts that the "form materials" are not structure of an apparatus or system. Moreover, while the Examiner contends that the discover production mechanism can be an apparatus, since the appellant has not identified or defined what the structure is, broadly reading it in light of the claim limitations, it can be a stapler since a stapler is fully capable of combining stored discovery related information and form discovery materials to produce discovery items for use in litigation.

...

¹²The Examiner also requests the appellant to identify the term "analyzer" since it is not defined in the specification nor identified in the drawings.

In the instant Appeal Brief, appellant states:

Fourth, the Office Action requested identification of an "analyzer." Applicants respectfully submit that numerous examples have been described above, such as with reference to ¶ 36, and no further explanation is necessary here. Again, this response was previously provided and not addressed.

In the Remarks/Argument section submitted with the amendment on June 21, 2006, appellant stated:

Fourth, the Office Action requested identification of an "analyzer." Applicants respectfully submit that numerous examples have been described above, such as with reference to ¶ 36, and no further explanation is necessary here.

Thus, the Examiner asserts that the appellant has never responded to this question or defined or identified the term "analyzer". The Examiner asserts that as such, the term "analyzer" can encompass a human being.

... ¹³The Examiner states in the Office Action mailed on September 7, 2006 that the appellant fails to identify what an assessor is in the specification. The Examiner notes that the appellant has yet to respond to this rejection by identifying or defining the

¹² Examiner's Answer, p. 39

¹³ Examiner's Answer, p. 39

term "accessor". The Examiner asserts that as such, the term "accessor" can encompass a human being.

Appellant states that the Office Action requests that appellant define the term "tool". In response, the appellant states:

As noted in the Office Action, Applicants are using normal meaning for the term. For example, tool as a noun is defined as "something (as an instrument or apparatus) used in performing an operation or necessary in the practice of a vocation or profession" in Webster's Ninth New Collegiate Dictionary. When the specification and claims are reviewed, Applicants submit that their use of the word is consistent with that definition, an ordinary meaning of the word "tool." The Office Action provided no response to this argument, simply adding the note which appears to answer the question. Applicants submit that the rejection is improper.

Since the appellant states that a tool is an instrument or apparatus, the Examiner asserts that it is unclear how a menu, form discovery materials, weighting values resultant values, etc. provide structure to the apparatus.

NOTE: The appellant defined "a tool" in the arguments submitted on June 21, 2006 as something (as an instrument or apparatus) used in performing an operation or necessary in practice of a vocation or profession).

The Examiner requested that the appellant clarify what appellant means by the following language in claim 1 - *an entry field available on a plurality of views not directly related to discovery to request collection of discovery request?*

In the instant Appeal Brief, appellant states that:

Again Applicants responded in the June 21, 2006 response and the Office Action failed to address the response. As a specific embodiment, and not a limitation to the claim language, Applicants refer to ¶¶ 53 and 54 and to Figs. 4, 99 and 100. As seen on Fig. 4, there is a button labeled "Discovery Generator." Clicking this button results in the drop down box shown in Fig. 100 appearing on screen. The drop down box is for entering specific discovery questions. As the "Discovery Generator" button is present on screens not directly related to discovery, as in Fig. 4, this Discovery Questions entry area is available on these other views. Applicants again note that this is a specific explanation of a specific described

embodiment and is not to limit the meaning of the claim term to that specific example.

The Examiner asserts that this still does not clarify what is meant by the field being available on a plurality of views not directly related to discovery to request collection of discovery request.

The Examiner asserts that claim 8 identifies the invention as "a tool". However, the body of the claim language states that there are a plurality of tools according to claim 5 and requested the appellant to clarify this.

In the instant Appeal Brief, appellant states that:

Fifth and finally as to the indefiniteness rejections, the Office Action is confused by the use of "tool" for both claim 5 and claim 8 which incorporates claim 5. *Applicants repeat these remarks from the prior response*, which also was not addressed by the Office Action. Claim 5 defines a singular tool according to the present invention, a tool to recommend a particular decision in a litigation. Claim 8 uses a plurality of the singular tools of claim 5 to assess a litigation. Thus claim 8 utilizes the various decisions *provided by the plurality of tools of claim 5 used as elements in claim 8 to provide an assessment of the litigation*. As an analogy, if claim 5 were to claim a wrench, then claim 8 would include a plurality of the wrenches of claim 5. The claim format, while unusual, is proper and Applicants submit that the rejection should be reversed.

First, the Examiner notes that appellant has never really addressed this in a prior response. In the Remarks/Arguments section submitted on June 21, 2006, the appellant simply states:

Fifth and finally, the Office Action is confused by the use of "tool" for both claim 5, and claim 8 which incorporates claim 5. Applicants submit that the response related to the claim objections addressed this rejection.

Claim Objections

Claims 8-12 were objected to as being of improper dependent form. Applicants respectfully traverse the objection. Claim 8 is an independent claim, not a dependent claim, and is of proper form. Claim 5 defines a singular tool according to the present invention, a tool to recommend a particular decision in a litigation. Claim 8 uses a plurality of the singular tools of claim 5 to assess a litigation. Thus

claim 8 utilizes the various decisions provided by the plurality of tools of claim 5 used as elements in claim 8 to provide an assessment of the litigation. As an analogy, if claim 5 were to claim a wrench, then claim 8 would include a plurality of the wrenches of claim 5. The claim format, while unusual, is proper and Applicants submit that the objection should be withdrawn.

Again, the Examiner asserts that appellant has failed to clarify the claim limitations. Appellant states that claim 8 utilizes the various decision provided by the plurality of tools of claim 5 to provide an assessment. However, claim 5 is only directed to one tool. Moreover, if this is the same litigation, why would you use a plurality of the tools as set forth in claim 5? Where do the various decisions come from in claim 5?

D. Section 101 Rejections

Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

...

¹⁴ Claim 5 is directed to a tool comprising interfaces, storage, weighting values, an analyzer, resultant values and a recommendation element. The Examiner asserts that interfaces can be software and that weighting values and resultant values clearly are not structure. Appellant has not defined the term "analyzer" in the specification nor identified it in the drawings. The broadest reasonable interpretation of the term "analyzer" could encompass a human being. Since appellant states that the tool is an apparatus, a human analyzer could also render the claim non-statutory.

¹⁴ Examiner's Answer, p. 43

Claim 8 is directed to a tool comprising a plurality of tools according to claim 5, interfaces, storage, and an accessor. As set forth above, interfaces can be software. Again, appellant has not defined the term "accessor" in the specification or identified it in the drawings. Thus, the broadest reasonable interpretation of the term "accessor" can encompass a human being.

Therefore, the invention does not clearly fall into the statutory class of process or method. It is not an article of manufacture or a composition of matter. Therefore, the invention appears to be non-statutory.

NOTE: In appellant's remarks submitted with the amendment filed on June 21, 2006, appellant states that the claims are properly classified as apparatus or system claims. The appellant states that the present claims are a combination of graphical user interface elements and related data fields, physical storage, stored information, and a generally computer implemented process (page 9). Stored information is not structure. Data fields are not structure. Moreover, the appellant has not claimed a graphical user interface element.

Furthermore, it is not clear whether the tool is software or a web site or web pages. Although appellant states that a "tool" is defined as "something (as an instrument or apparatus) used in performing an operation or necessary in the practice of a vocation or profession", software can also be something used in performing an operation or necessary in the practice of a vocation or profession. Moreover, appellant's specification states that Figure 2 illustrates an exemplary computer system for operating a tool according to the present invention (see paragraphs [0017] and [0027]).

Even though appellant states that the invention is directed to an apparatus, the claims could be construed to be drawn to a web site or web pages. Claims drawn to web sites or web pages require careful analysis. It should be determined whether such a claim is drawn to a collection of files or to computer or network hardware. The fact that appellant is claiming an entry field, a menu, form discovery materials, interfaces for gathering information does not preclude the appellant's invention from being directed to a web site or web pages.

...

¹⁵ Claims 5-12 are further rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.

An analysis of the appellant's claimed invention as to whether it is statutory or not under 35 USC Section 101 because of this subjective analysis and because of the lack of guidance and direction as to what and how to apply the numerical values is set forth below.

35 U.S.C. § 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter.

To properly determine whether a claimed invention complies with the statutory invention requirements of 35 USC Section 101, the Examiner must first identify whether the claims fall within at least one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or composition of matter). As set forth above, it is unclear to the Examiner what statutory class appellant's invention falls into. However, in the instant Appeal Brief, appellant states that:

The first § 101 rejection was based on non-statutory subject matter. Applicants submit this rejection has been addressed above with the § 112, ¶ 2 rejection, where it was clearly illustrated *the present claims are properly apparatus claims*. The Office Action makes various remarks about data fields not being structure and files or documents being functional or non-functional descriptive material. The common error in these remarks, in particular, and in the § 112, 2nd paragraph and § 101 rejections on this point in general, is that the citations and rejections are based on rules and policies relating to the claim as a whole, not to individual elements. It is clear that it is the claim as a whole that must be reviewed. One cannot simply find one element and declare the claim non-statutory on that basis, which appears to be the approach taken in the Office Action.⁵ This further is the case when the allegedly non-statutory elements are utilized in or products of other clearly statutory elements.

¹⁵ Examiner's Answer, p. 45

Therefore, as an apparatus, the appellant's invention falls into one of the enumerated classes.

Upon making the determination that the invention is an apparatus that falls within enumerated statutory classes, the Examiner must now determine whether the claimed invention falls within one of the Section 101 judicial exceptions, i.e., is the invention directed to laws of nature, natural phenomena or an abstract idea.

Inventions directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible and therefore are excluded from patent protection. *Diehr*, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., *Chakrabarty*, 447 U.S. at 309, 206 USPQ at 197; *Parker v. Flook*, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); *Benson*, 409 U.S. at 67-68, 175 USPQ at 675; *Funk*, 333 U.S. at 130, 76 USPQ at 281. "A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right." *Le Roy*, 55 U.S. (14 How.) at 175. Instead, such "manifestations of laws of nature" are "part of the storehouse of knowledge," "free to all men and reserved exclusively to none." *Funk*, 333 U.S. at 130, 76 USPQ at 281.

The Examiner asserts that the appellant's invention appears to provide a score which is translated into a recommendation. The Examiner asserts that this score is an aggregation of the user's subjective judgment. Thus, the Examiner asserts the appellant's invention is nothing more than a mathematical formula used to provide a score which is translated into a recommendation, thus is a mathematical expression, and, therefore, is an abstract idea. As stated above, one cannot patent "a novel and useful mathematical formula."

However, the evaluation under 35 USC Section 101 does not stop here. While abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be. In evaluating whether a claim meets the requirements of section 101, the claim must be considered as a whole to determine whether it is for a particular application of an abstract idea, natural

phenomenon, or law of nature, rather than for the abstract idea, natural phenomenon, or law of nature itself.

The Examiner must ascertain the scope of the claim to determine whether it covers either a § 101 judicial exception or a practical application of a § 101 judicial exception. The conclusion that a particular claim includes a § 101 judicial exception does not end the inquiry because "[i]t is now commonplace that an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection." *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis in original); accord *Flook*, 437 U.S. at 590, 198 USPQ at 197; *Benson*, 409 U.S. at 67, 175 USPQ at 675. Thus, "[w]hile a scientific truth, or the mathematical expression of it, is not a patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be." *Diehr*, 450 U.S. at 188, 209 USPQ at 8-9 (quoting *Mackay*, 306 U.S. at 94); see also *Corning v. Burden*, 56 U.S. (15 How.) 252, 268, 14 L.Ed. 683 (1854) ("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted ...").

For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. *Diehr*, 450 U.S. at 187, 209 USPQ at 8 ("application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection."); *Benson*, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it "has no substantial practical application").

To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways:

- (a). The claimed invention "transforms" an article or physical object to a different state or thing.
- (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The Examiner asserts that the appellant's invention does not transform an article or physical object to a different state or thing. Calculating a metric (score) using a

formula on a computer does not transform an article or physical object to a different state or thing.

For eligibility analysis, physical transformation "is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application." AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. Since the Examiner determined that the claims do not entail the transformation of an article, the Examiner must review the claim to determine if the claim provides a practical application that produces a useful, tangible and concrete result. In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete." The claim must be examined to see if it includes anything more than a § 101 judicial exception. If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101. If the examiner does not find such a practical application, the examiner has determined that the claim is nonstatutory. In determining whether a claim provides a practical application that produces a useful, tangible, and concrete result, the examiner considers and weighs the following factors:

1). Whether the invention produces a "concrete" result?

Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art.

The Examiner asserts that the appellant's invention does not produce a repeatable or predictable result.

Claim 5 is directed to a tool comprising interfaces, storage, weighted values, an analyzer, resultant values and a recommendation element. Claim 5 is directed to associating weighting values with each element and an analyzer using the stored information and the associated weighted values to determine a resultant value, said resultant values associated with various decision options, and a recommendation element using the determined resultant value and the associated decision options to provide a recommended decision.

Claim 8 is directed to a tool comprising a plurality of tools, interfaces, storage and an accessor. Claim 8 discloses an accessor utilizing the decisions of each of the plurality of tools for providing an assessment relating to litigation. At the onset, the Examiner notes that neither the term "analyzer" nor the term "accessor" are identified in the body of the specification or any of the drawings. The only place that these terms are found are in the claim limitations. Thus, the Examiner asserts that the broadest reasonable interpretation of these terms can encompass a human being.

The Examiner further asserts that the specification fails to provide sufficient guidance and direction to enable one skilled in the art to make or use the invention without undue experimentation.

...

...¹⁶ Appellant has not defined how what scale is used, what the weighted analysis values are or how they are applied, or how the resulting score can be translated into a recommendation. As stated by appellant in the Appeal Brief (page 12), the actual numerical values would likely vary based on the specific techniques utilized.

...

...

¹⁷The Examiner notes appellant's argument wherein appellant states:

¹⁶ Examiner's Answer, p. 62

¹⁷ Examiner's Answer, p. 63

The second § 101 rejection is based on a requirement that the invention produce a useful, concrete and tangible result and a confusion about the use of subjective values in the invention.

While Applicants believe this has been addressed under the § 112, ¶ 1 Enablement and Utility rejections, Applicants again note that the Office Action is confusing input data with the operation of the invention. For a given set of input data, the invention will always produce the same result, a useful, concrete and tangible result, for claim 5 a recommendation and for claim 8 an assessment. Different inputs may well produce different results, but such is generally true.

Applicants submit that the § 101 rejections are improper and should be reversed.

The Examiner respectfully disagrees with the appellant's assertion and contends that the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to provide repeatable and predictable results - to the point that the users become the inventor of their own application of the invention rather than the applicant.

E. Section 102 Rejection

Claim 1

Appellant states that Newell is not related at all to developing discovery materials but instead Newell is simply a litigation management system, a hyperlinked database of all of the information and materials in the litigation.

The Examiner asserts that while Newell is a system and method for managing litigation information, Newell also discloses discovery information where each discovery entry includes a description of discovery document [0013]. The plurality of categories and subcategories in Newell include discovery information [0030-0031]. Also, see Figures 3J-1 thru 3J-2 (Discovery web pages) and the discussion in paragraphs [0141-0144]; Figure 2 (202J) Discovery.

Appellant states that Newell only contains previously developed material. Appellant states that Newell does not contain "an entry field available on a plurality of

views not directly related to discovery to request collection of discovery requests" nor "a discovery production mechanism to combine stored discovery related information and form discovery materials to produce discovery items for use in the litigation."

Appellant states that appellant specifically notes that the two specific examples mentioned, the entry field and the discovery production mechanism, which distinguish appellant's invention from Newell, are not elements which were the basis of the § 112 or § 101 rejections. Therefore, appellant states that there was no valid basis for simply ignoring most of the language of the claim elements.

The Examiner respectfully disagrees with the appellant's assertion. As to both the "entry field" and the discovery production mechanism, the Examiner has made numerous attempts to get the appellant to clarify the limitations.

Appellant is directed to the discussion under the rejection under 35 U.S.C. 112, 2nd paragraph wherein the following is stated:

The Examiner requested that the appellant clarify what appellant means by the following language in claim 1 - *an entry field available on a plurality of views not directly related to discovery to request collection of discovery request?*

In the instant Appeal Brief, appellant states that:

Again Applicants responded in the June 21, 2006 response and the Office Action failed to address the response. As a specific embodiment, and not a limitation to the claim language, Applicants refer to ¶¶ 53 and 54 and to Figs. 4, 99 and 100. As seen on Fig. 4, there is a button labeled "Discovery Generator." Clicking this button results in the drop down box shown in Fig. 100 appearing on screen. The drop down box is for entering specific discovery questions. As the "Discovery Generator" button is present on screens not directly related to discovery, as in Fig. 4, this Discovery Questions entry area is available on these other views. Applicants again note that this is a specific explanation of a specific described embodiment and is not to limit the meaning of the claim term to that specific example.

The Examiner asserts that this still does not clarify what is meant by the field being available on a plurality of views not directly related to discovery to request collection of discovery request.

The Examiner asserts that claim limitations are to define what the invention is, not what it is not. Thus, the Examiner asserts that the appellant has failed to positively claim appellant's invention.

As for the appellant's assertions as to the "discovery production mechanism" the Examiner notes the rejection under 35 U.S.C. 112, 1st paragraph. Although this rejection has been **withdrawn**, the Examiner and the appellant have had the following dialog as evidenced by the rejection mailed to appellant on September 7, 2006:

For example, in claim 1, the appellant claims a discovery mechanism to combine discovery related information and form discovery materials to produce discovery items for use in litigation. The specification fails to provide an adequate written description of the invention so that one of skill in the art could practice the claimed invention without undue experimentation. The specification does not describe how to combine stored discovery related information and form discovery materials to produce discovery items, what mechanisms are used to make such combination, or how the data or what data is merged in such a way as to enable one skilled in the art to make or use the invention.

...

¹⁸Appellant's discloses in the specification, paragraph [0054], that the tool selects the particular discovery question and merges them with other form discovery materials. The appellant does not disclose how the tool selects the particular question or how the data is actually merged with other form discover materials. It is not clear what the actually gets incorporated into the materials or what the final product is.

The Examiner has **withdrawn** the rejection and will instead take the broadest reasonable interpretation of the term "discovery production mechanism to combine

¹⁸ Examiner's Answer, p. 68

information and materials". The Examiner asserts that a stapler is fully capable of being a "discovery production mechanism to combine information and materials".

Thus, in applying prior art to claim 1, if a tool is an apparatus as asserted by applicant, then the prior art need only read on the structure of the apparatus. The Examiner asserts that an entry field does not describe structure of an apparatus. Furthermore, an entry field can be any template on a screen for entering data as is disclosed in Newell (Figure 1a, [0056]; see also Figures 4B-1-5A). Newell discloses a menu (Figure 3A), storage [0024-0029] [0109], forms (Figure 3B-2 Common case Forms; Figure 2 (202W Special Verdict Forms)) and a production mechanism for combining documents [0100-0101] [0141-0144]).

Appellant has admitted that the invention is directed to an apparatus. Thus, the fact that the tool is for developing litigation discovery material is the intended use of the tool and given little patentable weight. Moreover, the fact that the menu is for gathering information is also intended use of the "apparatus" as claimed by appellant and also is given little patentable weight.

The Examiner further notes that limitations reading "discovery **related** information" or "information **related** to discovery" or "information **relevant** to the litigation can broadly be read to be about any kind of information.

Claim 5:

Appellants states that Newell is not related at all to recommending a decision in litigation, Newell being merely a hyperlinked database of case information. As such, appellant states that Newell does not disclose any of the claim elements starting at "weighting values associated with each element of selected information." Appellants also note that the Office Action has failed to even make a prima facie rejection. Appellant asserts that, in addition to ignoring most of the element language, as done with claim 1, it [the Office Action] has failed to even cite an element in Newell which corresponds to the claimed recommendation element. Appellant asserts that the rejection is improper on its face and must be reversed.

Here again the Examiner will consider claim 5 to be directed to an apparatus. The fact that the tool is **for recommending a decision in litigation** is the intended use of the apparatus, and thus is given little patentable weight. Claim 5 is directed to a tool comprising interfaces (this could be software and as claimed, is not a positive recitation of structure), storage, and an analyzer (processor unit 112).

The fact that the interface is **for gathering information** is intended use of the interface and thus, in an apparatus claim, is given little patentable weight. The fact that the storage is **for gathering information** is also intended use. The Examiner asserts that weighing values/ resultant values are clearly not proper structure of an apparatus. Since it is not clear from appellant's disclosure what defines a recommendation element, the Examiner asserts that processor unit 112 could process the resultant values and associate decisions.

Claim 8:

Appellants again state that Newell is not related at all to assessing a litigation, Newell being just a hyperlinked database. As such, appellant's assert that Newell clearly does not disclose the "plurality of tools according to claim 5, each tool for a decision in the litigation" or "assessor utilizing the decisions of each of said plurality of tools and the stored further selected information for providing an assessment." Appellants state that as above in the rejections of claims 1 and 5, most of the language in each element has been omitted. And, similar to claim 5, the Office Action has failed to even cite an element in Newell corresponding to the assessor element in claim 8. Appellant asserts that again the rejection is improper on its face and must be reversed.

Once again the Examiner asserts that claim 8 is directed to an apparatus. Therefore, the fact that the tool is **for assessing a litigation** is the intended use of the tool. Thus, claim 8 is directed to a tool, comprising a plurality of tools, interfaces, storage and an accessor. As set forth above in the rejection under 35 U.S.C. 112, 2nd paragraph, the appellant has failed to define the "accessor" in the specification and does not identify it in the drawings. As such, the broadest reasonable interpretation of an accessor can be a human being which would render the claim 8 non-statutory.

MPEP 2105 states that:

If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter. Furthermore, the claimed invention must be examined with regard to all issues pertinent to patentability, and any applicable rejections under 35 U.S.C. 102, 103, or 112 must also be made.

Moreover, since the appellant has not defined the accessor and since the invention is directed to an apparatus, the processor unit 112 in Newell could be the accessor.

Office Action Response

The appellant states that the Office Action did provide some response to appellant's arguments on the § 102 rejections. Appellant states that most of the remarks related to defining which elements would not be considered structure, and thus apparently would be omitted from the rejection. Appellants submit that this approach is improper, particularly as the elements are proper as discussed above repeatedly. Appellants assert that even then the rejections are inconsistent with this improper approach. First, appellant asserts that the approach would not justify omitting most language in each element, which language was never mentioned as being improper. Yet this was done, as discussed above. Second, appellant asserts that the approach would not justify totally omitting elements never mentioned as being improper, as was done in the rejections of claims 5 and 8, as noted above. Thus, appellant asserts that the rejections are inconsistent even with the improper remarks, further reason for the rejections to be reversed. Applicants submit that the § 102 rejections are improper and must be reversed.

The Examiner respectfully disagrees with the appellant's assertions. The Examiner cited numerous rejections under 35 U.S.C. 112, 2nd paragraph and also provided the following statement leading into the rejection under 35 U.S.C 102:

The Examiner finds that because claim(s) 1-12 are replete with 35 U.S.C. 112 2nd paragraph indefiniteness rejections, it is difficult if not impossible to completely construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections even though the claim(s) contain 35 U.S.C. 112 2nd paragraph rejections, the claims are construed and the art is applied as *much as practically possible*. As noted below, Applicant(s) are invited to contact the Examiner if additional assistance is needed.

The Examiner also provided the following to the appellant in the Office Action mailed on September 7, 2006:

The appellant argues that Newell is not related to recommending a decision in litigation and Newell does not disclose weighted values. Appellant's claim language is directed to a tool for developing litigation discovery material, a tool for recommending a decision and a tool for assessing a litigation. The Examiner asserts that since appellant states that the claimed invention is directed to an apparatus, then the data stored or input into the structure would be nonfunctional descriptive data, not functionally related to the structure of the invention. A data entry field would be an interface. The data displayed would not be functionally related to the structure. A menu is a display of data. The intended use of the menu is given little patentable weight if the apparatus or system of Newell is capable of having a menu. Storage is storage of data, generally a database. What is stored in the database in non-functional descriptive data. Form discovery materials are not considered to be structure. Weighted values are not considered to be structure.

Thus, the Examiner asserts that as appellant has claimed appellant's invention, Newell applies as prior art and appellant's claim language does not distinguish from the prior art.